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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1971.

**No. 71-1457**

MONSANTO COMPANY,

*Petitioner,*

*vs.*

ROHM & HAAS COMPANY,

*Respondent.*

## PETITIONER'S REPLY TO THE BRIEF FOR THE RESPONDENT IN OPPOSITION.

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THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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### THE RESPONDENT'S BRIEF ONLY EMPHASIZES THAT THE UNDERLYING BASIS OF THE DECISIONS BELOW IS AN UNWARRANTED DEPARTURE FROM THE LAW OF OBVIOUSNESS UNDER 35 U. S. C. § 103 AS IT STOOD IN 1967 AND AS IT HAS STOOD UNTIL NOW.

The respondent's argument exemplifies its prejudicial use of half-truths by which it succeeded in convicting the petitioner of that very misconduct. The petitioner will not presume upon this Court's patience by taking this occasion to reply to respondent's endless supply of misleading statements. The petitioner has not asked this Court to re-try the case, but to answer the important Questions Presented in the petition.

The respondent's argument that the dispute is an essentially factual one is simply not true no matter how many

fact-based arguments it makes. The emphasis upon the chemical facts in the respondent's brief is far more revealingly relevant to the trial court's refusal to "buy" the law of obviousness of a chemical compound under 35 U. S. C. § 103 as it stood in 1967 and to its pronouncement of a new law of obviousness under which immaterial facts became material to patent validity and the "withholding" of them became fraud.

At issue in the prosecution of the Huffman patent in suit was the obviousness or nonobviousness of a new herbicide. Its chemical structure was new and its important herbicidal property was not suggested by known properties of any structurally similar prior art chemical compounds. Judge Masterson believed, however, that if the *structure* of the new compound, quite apart from the properties which made it significant, was not in itself an unobvious departure from the *structure* of known compounds, the discoverer of the new compound should not be entitled to a patent except on the method of using the compound. It is under this patent-defeating theory that the respondent argues that "Monsanto's patent at bar withdrew from the public domain the right to use 3,4-DCPA as a source of pigment coloring materials." (Resp. Br. p. 7.)* In making this argument, the respondent is not alleging that 3,4-DCPA is in fact used for coloring pigments or that 3,4-DCPA was in fact in the public domain before petitioner discovered it.

The respondent's unrealistic argument, which the trial court "bought", is that since the new compound 3,4-DCPA is structurally very similar to the old compound 3,4-DCAA, which old compound had a published use as an intermediate in pigment production, the fact that 3,4-DCPA could be shown to have a pigment-producing capability put 3,4-DCPA in the public domain. The fact, of course, is

* "Resp. Br. p. ....." references are to the pages in the Respondent's Brief.

that something significantly new was added to public knowledge—a *new compound having outstanding properties as a herbicide, which properties which no one had previously suggested might exist.* The respondent, it should be noted, is not using 3, 4-DCPA for pigment production any more than it is using 3, 4-DCAA as a herbicide. It is selling 3, 4-DCPA for others to use as a herbicide, and its claim that it was "the pioneer in the sale of 3, 4-DCPA" (Resp. Br. p. 5)—in the light of the evidence in this record —simply affirms that it was the first, of several, infringers of petitioner's patent to the compound.

The manner in which the district court below employed the *Henze** decision to support its view that only process claims met the patentability requirements is contrary to the law as it stood in 1967, and it is contrary to the law today (unless the precedent below were to be allowed to stand as the new law on the Section 103 patentability issue). What the district court did was to make the correctness of the unobviousness determination hinge upon the presence in the prior art of properties which were neither known nor suspected when the new herbicide was discovered. This false doctrine had been put aside by the Court of Customs and Patent Appeals in *In re Papesch*, 315 F. 2d 381 (CCPA 1963) and by the decision of the District Court for the District of Columbia in *Deutsche Gold-und Silber-S* v. *Commissioner of Patents*, 251 F. Supp. 624 (1966) (later affirmed by the Court of Appeals for the District of Columbia Circuit in 1968 at 397 F. 2d 656). The respondent's argument that materiality of facts not submitted to the Patent Office in 1967 must be judged by the state of the law as it then stood (Resp. Br. p. 31) is correct, but by 1967 the *Henze* dictum had been repudiated by the court which originated it. The recent explicit overruling of *Henze* in *In re Stemniski*, 444 F. 2d 581 (CCPA

*In re Henze*; 181 F. 2d 196 (CCPA 1950).

1971) was only the *coup de grace* for a fallacious precedent which had been criticized and distinguished in many post-*Henze* decisions.

Since this petition was filed, the Court of Appeals for the Fifth Circuit filed its opinion on May 18, 1972 in *Eli Lilly & Company, Inc. et al.* v. *Generix Drug Sales, Inc., et al.*, ..... F. 2d ....., ..... U. S. P. Q. ....., Appeals Nos. 71-1797, 71-2642, 71-2771. Its ruling there on the same patentability issue which underlies the decision below confirms the importance and the error of the submerged portion of the opinion to which this petition is addressed:

> "In the case at bar, we necessarily decide the issue which we did not have to reach in *Monsanto Co.* v. *Dawson, Chemical Co.*, 312 F. Supp. 452 (S. D. Tex. 1970), *rev'd on other grounds* 443 F. 2d 1035 (5th Cir. 1971). In that case a chemical compound was discovered to exhibit novel, useful, herbicidal activity. An adjacent homologue was disclosed in the prior art, but recognized to be of value only in making pigment. That appeal was controlled by the application of collateral estoppel and we did not decide the merits. In today's holding, we follow the rationale which underlies the decision of the Court of Customs and Patent Appeals in *Application of Stemniski*, 444 F. 2d 581 (CCPA 1971); and *Commissioner* v. *Deutsche Gold-und-Silber-S.* 397 F. 2d 656 (D. C. 1968). See *Note: Patentability of Chemical Compounds*, 50 Tex. L. Rev. 566.
>
> In the field of drug patents today therapeutic value, not chemical composition, is the substance of all incentive to invent. Except where the state of the medical art and the state of the chemical art have been advanced and coordinated to the point that it is possible for the mind to conceive or predict with some minimal reliability a correlation between chemical analogues, homologues or isomers and their therapeutic value, reason compels us to agree that novelty, usefulness and non-obviousness inhere in the true discovery that a chemical compound exhibits a new needed

medicinal capability, even though it be closely related in structure to a known or patented drug. When such a fresh, efficacious, undisclosed use is identified, its inventor deserves the full ambit of statutory protection. A limitation to 'use' or process patentability, based solely on the existence of prior chemical formulations, would not accord with the basic constitutional power being exercised by the Congress to promote science and the useful arts. Such a niggardly patent reward for costly and painstaking research would discourage both the inspiration-perspiration process of the laboratory and the incentive to publicly disclose products of value to mankind." (Pages 13-15 of the slip opinion.)

The law of patentability and the constitutional policy behind it are the same for new compounds having major herbicidal properties as for new compounds having major therapeutic properties. Reality should govern. In the case at bar, the respondent admits that it, too, attempted to obtain a patent on 3, 4-DCPA. It failed to qualify. But having failed, it equates honesty with failure to obtain a patent (Resp. Br. p. 29) and dishonesty with obtaining a patent. Respondent's "most telling proof" of misrepresentation is that the Husted affidavit resulted in prompt allowance of the patent (Resp. Br. p. 3). Arguments of this caliber are so transparent as to suggest more telling evidence exists. It does. It is the evidence of the misdirected preference for what the Court of Appeals in *Eli Lilly & Co.* characterized as a "niggardly patent reward" limited to process claims.

The aberrant theory of patentability adopted by the trial court and approved without review by the appellate court was the foundation of the subsequent errors leading to the conclusions of invalidity and unenforceability. For the trial court to condemn as fraudulent the "withholding" of facts which an attorney following the statute

and the viable precedents under it would reasonably conclude were legally immaterial is to threaten the useful functioning of the patent system. For the appellate court to refuse to even review the real basis of a far-reaching and dangerous decision is to abandon responsibility for the orderly development of the law in an area where order is badly needed.

## CONCLUSION.

The useful functioning of the patent system is threatened. Grant of the petition for writ of certiorari would provide much needed guidance.

Respectfully submitted,

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